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10/755,812

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Hao Xue

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09/26/2007

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EXAMINER

RAMAKRISHNAIAH, MELUR

ART UNIT

PAPER NUMBER

2614

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|----------------------------------|----------------------------|--|
| Office Action Summary | Application No. 10/755,812 | Applicant(s) XUE ET AL. | |
| | Examiner Melur Ramakrishnaiah | Art Unit 2614 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 July 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 29-33,35-41,43 and 44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 29-33,35-41,43 and 44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>8-23-2004</u> . | 6) <input type="checkbox"/> Other: _____ |

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7-23-2007 has been entered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 29-33, 35-36, 37-41, 43-44 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. For example amended independent claim 29 recites: where in the mobile data device gives preference to various ones of the plurality of system preference criteria to create the ranking of available networks. Regarding this limitation, Applicant's specification does not have support for this, especially mobile data device creating ranking of available networks. All available evidence in applicant's

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specification points to non-existence of mobile data device creating ranking of available networks. As can be seen from the specification: Each mobile device includes a preferred roaming list (PRL) built into it, which assists the device to perform system selection and acquisition (page 2 lines 5-9). Further only place applicant specification talks about rank is in page 6 lines 25-28 which says: The PRL then ranks the priority of each system. This clearly shows that PRL with rank has already built into it user preferences for selection of networks as described in table 1. This in no way supports applicant's amended claim limitation such as mobile data device creating ranking of available networks. Similar remarks apply to claim 37.

4. The amendment filed on 7-23-2007 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: Addition of this at page 6, lines 25-27, viz: "The then current PRL list of preferred networks is considered together with the then available networks to derive a ranked list of available networks" constitutes new matter.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 29-30, , 37-38, 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aerrabotu et al. (US PAT: 6,993,336, filed 12-15-2003, hereinafter Aerrabotu) in view of Chiniga et al. (US PAT: 6,415,148, hereinafter Chiniga).

Regarding claim 29, Aerrabotu discloses a method for mobile data device to determine a network to acquire based on a plurality of system preference criteria provided in a preferred roaming list on the mobile data device, the method comprising the steps of: waiting until a new network needs to be acquired, choosing the network to acquire at the mobile data device (reads on 102, figs. 1, 7) based on plurality of system preference criteria stored on the mobile device, starting a search for the new network wherein mobile data device gives preference to various ones of the plurality of system preference criteria to select a network (col. 2, line 39 – col. 4, line 58).

Regarding claim 37, Aerrabotu discloses mobile data device for acquiring one of plurality of networks based on a plurality of system preference criteria provided in the preferred roaming list on the mobile data device, characterized by means for: waiting until a new network seems to be acquired, choosing the network to acquire at the mobile data device (reads on 102, figs. 1, 7) based on the plurality of system preference criteria stored in the mobile device, starting a search for the new network, wherein mobile data device gives preference to various ones of the plurality of system preference criteria to select a network (col. 2, line 39 – col. 4, line 58).

Aerrabotu differs from claims 29 and 27 in that it does not teach: mobile device gives preference to various one of the plurality of system preferences criteria to create the ranking of the available networks.

However, Chiniga discloses system and method for the detection of service from alternate wireless communication system which teaches: mobile device gives preference to various one of the plurality of system preferences criteria to create the ranking of the available networks (col. 9 lines 6-50).

Thus it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Aerrabotu's system to provide for the following: mobile device gives preference to various one of the plurality of system preferences criteria to create the ranking of the available networks as this arrangement would provide means to select more desirable service provider to meet user needs as taught by Chiniga.

Regarding claims 30, 38, 44, Aerrabotu further teaches: plurality of system preference criteria includes geographic information and data capability information (col. 3 lines 36-63), the mobile data device includes means for storing the plurality of system preferences criteria in a table with the available networks (fig. 2, col. 3 lines 9-35).

7. Claims 31-33, 39-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aerrabotu in view of Chiniga as applied to claims 30, 38 above, and further in view of Guilford et al. (US2002/0087674 A1, hereinafter Guilford).

The combination differs from claims 31-33, 39-41 in that it does not specifically teach: plurality of system criteria include information about whether each of the available networks support: data roaming for mobile data device, support mobile IP, always-on device.

However, Guilford discloses intelligent network selection based on quality of service and applications over different wireless networks which teach: plurality of

system criteria include information about whether each of the available networks support: data roaming for mobile data device, support mobile IP, always-on device (paragraphs: 7-16; 21-23; 27-28; 45; 51-62; 66-67; 72-73, 79; figs. 2, 4, 7a).

Thus it would have been obvious to one of ordinary skill in the art at the time invention was made to modify the combination to provide for the following: plurality of system criteria include information about whether each of the available networks support: data roaming for mobile data device, support mobile IP, always-on device as this arrangement would provide the user to select required service based on his needs as taught by Guilford, thus providing means to meet user needs.

8. Claims 35 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aerrabotu in view of Chiniga as applied to claims 30, 38 above, and further in view of Seppanen et al. (US PAT:5,903,832, hereinafter Seppanen).

The combination differs from claim 35 in that it does not teach: mobile data device stores a list of service features that mobile data device supports and plurality of system preference criteria includes a list of services the network supports.

However, Seppanen discloses mobile terminal having enhanced system selection capability which teaches: storing prioritized list of all networks and selecting desired network to meet services capable of being handled by mobile terminal (abstract and claim 19).

Thus it would have been obvious to one of ordinary skill in the art at the time invention was made to modify the combination to provide for the following: mobile data device stores a list of service features that mobile data device supports and

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plurality of system preference criteria includes a list of services the network supports as this arrangement would provide means for selecting and using networks to meet desired user services such as data service or fax service etc as taught by Seppanen (col. 4 lines 38-52).

Claim 43 is rejected on the same basis as claim 35.

9. Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over Aerrabotu in view of Chiniga as applied to claim 29 above, and further in view of Russell (US 2004/0249915).

The combination differs from claim 36 in that he does not teach the following: choosing step can find no networks are available.

However, Russell teaches the following: choosing step can find no networks are available (fig. 8, paragraph: 0096).

Thus it would have been obvious to one of ordinary skill in the art at the time invention was made to modify the combination to provide for the following: choosing step can find no networks are available as this arrangement would facilitates the user to learn the no network is available for connection as taught by Russell, so that user is not kept in darkness as to availability of the network.

Response to Arguments

10. Applicant's arguments with respect to claims 29-33, 35-41, 43-44 have been considered but are moot in view of the new ground(s) of rejection.

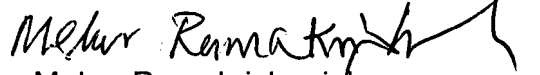
Rejection of claims 29-33, 35-36, 37-41, and 43-44: rejected under 35 U.S.C 112 first paragraph: regarding rejection of the claims, Applicant on pages 4-5 of his response to the rejection gives various explanation including reciting passages from the specification to support his claim that Applicant specification has support for the claim limitation: where in the mobile data device gives preference to various ones of the plurality of system preference criteria to create the ranking of available networks. But applicant has failed to point out where exactly he has support in his specification for this limitation other than saying that a person of ordinary skill in the art would understand in lingo of the art that the "PRL" recitation encompasses the PRL list itself and related functionality including functionality of the manipulating the list such as, for example ranking the available networks. But this hardly equivalent to mobile device creating ranking of available networks. Therefore rejection of the claims 29-33, 35-36, 37-41, and 43-44 under 35 U.S.C 112 first paragraph is maintained.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melur Ramakrishnaiah whose telephone number is (571)272-8098. The examiner can normally be reached on 9 Hr schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curt Kuntz can be reached on (571) 272-7499. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Melur Ramakrishnaiah
Primary Examiner
Art Unit 2614